

REMARKS

Claims 1-16 and 23 are currently pending in this application. Claim 17-22 were previously canceled. Claims 1, 13 and 14 have been amended. New claim 23 has been added. No new matter has been added by these amendments or additions. Applicants have carefully reviewed the Office Action and respectfully request reconsideration of the claims in view of the remarks presented below.

Specification Objections

The specification was objected to because of a typographical error in paragraph [0037]. As indicated in the "Amendments to the Specification" section above, this error has been corrected.

Claim Objections

Claim 14 was objected to because of a typographical error. As indicated in the "Amendments to the Claims" section above, this error has been corrected.

Claim Rejections Under 35 U.S.C. §112

Claim 14 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the claim was rejected for including a gap between elements.

Claim 14 has been amended to include selective coupling between the pacing pulse generation circuitry and the ventricular coil electrode. In view of this amendment, the rejection under §112 is believed to be overcome.

Claim Rejections Under 35 U.S.C. §103

Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,044,295 (Pilz).

Pilz discloses an implantable medical device that includes two batteries. Both batteries are electrically coupled to control circuitry such that if the one battery that normally powers the control circuitry experiences a voltage drop, the other battery begins to power the control circuitry. See figure 1 and column 6, lines 46-56.

Applicants' claim 1 is distinct from Pilz in that it includes two separate batteries that serve two separate purposes, independent of each other. More specifically, claim 1 includes a first power source that powers pacing pulse generation circuitry and a second power source that is permanently electrically decoupled from the pacing pulse generator and thus operative to provide power only for the defibrillation shock generation circuitry.

In view of the foregoing, Applicant submits that Pilz does not teach or suggest the combination of elements and features recited in independent claim 1. Accordingly, Applicants request reconsideration of the §103 rejection of claims 1 and 3.

Claims 1, 2, 5, 7 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of U.S. Patent Publication No. 2004/0243183 (Norton).

As stated above, Pilz does not disclose the combination of features and elements recited in claim 1, including at least, a first power source that powers pacing pulse generation circuitry and a second power source that is permanently electrically decoupled from the pacing pulse generator and operative to provide power only for the defibrillation shock generation circuitry. Norton also fails to disclose this combination of elements and features. Accordingly, Applicants request reconsideration of the §103 rejection of claims 1, 2, 5, 7 and 9.

Claims 4 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of Norton and further in view of Official Notice. Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of Norton and further in view of U.S. Patent No. 5,558,962 (Marincic). Claims 10, 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of Norton and further in view of U.S. Patent No. 5,376,103 (Anderson). Claims 11, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of Norton and Anderson and further in view of U.S. Patent No. 5,755,742 (Schuelke). Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pilz in view of Norton, Anderson, Schuelke and further in view of U.S. Patent No. 4,796,630 (Regna).

In view of the foregoing analysis of independent claim 1 in view of Pilz and the combination of Pilz and Norton, Applicant believes that the rejections of claims 4, 6, 8 and 10-16 under §103 are rendered moot as each of these dependent claims depend from allowable independent claim 1.

Further regarding claim 13, it recites circuitry operative to hold ventricular and atrial ring electrodes at a voltage equal to that of a right ventricular coil. This feature is described in the specification as being contrary to normal device operation wherein the ring electrode is held at a voltage intermediate the voltage of the device case and the ventricular coil. See paragraph [0007], beginning at line 10; paragraph [0021], lines 1-10 and paragraph [0058]. Given the contrarian nature of claim 13, and the lack of Examiner citation to prior art that teaches or suggests the claimed feature, Applicants submit that one of ordinary skill in the art, would not have been motivated to deviate from the norm to arrive at claim 13. Furthermore, Applicants submit that given the rationale behind the holding of voltages as recited in claim 13, and the benefits it imparts, as also described in the specification, such feature is not a mere matter of “discovering an optimum value of a result effective variable” as suggested in the Office Action. Finally, the Examiner may wish to consult with Examiner Lee, who is responsible for application serial no. 10/761,981, wherein claim 13 – which recites a feature similar to claim 13 of the present application – was indicated as allowable.

Double Patenting

Claims 1-16 were provisionally rejected under the judicially created doctrine of double patenting over claims 1-16 of copending application serial no. 10/761,981 in view of Norton.

Applicant herein submits a Terminal Disclaimer disclaiming the terminal part of the statutory term of any patent granted on the present application, which would extend beyond the expiration date of the full statutory term of any patent issuing from copending application serial no. 10/761,981. In view of the Terminal Disclaimer and the preceding remarks, it is respectfully submitted that claims 1-16 are in condition for allowance.

New Claim 23

New claim 23 relates to an implantable pacemaker/defibrillation device that includes, in part, pacing pulse generation circuitry; defibrillation shock generation circuitry; a tip electrode and ring electrode for delivering pacing pulses; a coil electrode for delivering shocking pulses; and a switch operative to hold the ring electrode at a voltage equal to that of the coil electrode during shocking pulse delivery and to hold the ring electrode at a voltage relative to the tip electrode to deliver a pacing pulse.

For the same reasons presented above, and particularly those with respect to claim 13, Applicants believe that the art of record does not teach or suggest the combination of elements and features recited in claim 23.

CONCLUSION

Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. Therefore, allowance of Applicants' claims 1-16 and 23 is believed to be in order.

Respectfully submitted,

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Date

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